FISH & RICHARDSON P.C.

500 Arguello Street
Suite 500
Redwood City, California
94063-1526

Telephone
650 839-5070

Facsimile
650 839-5071

Web Site
www.fr.com

Frederick P. Fish
1855-1930

W.K. Richardson
1859-1951

BY FAX AND MAIL

March 29, 2002

Perry Clark, Esq.
Weil, Gotshal & Manges LLP
201 Redwood Shores Parkway
Redwood Shores, CA 94065

Re: Arthrocare Suit - Delaware
USDC-D. Del. - C.A. No. 01-504-SLR

Dear Perry:

Pursuant to the discussion during the discovery conference, I have enclosed Smith & Nephew's supplemental noninfringement and invalidity responses, which are subject to and made without waiving Smith & Nephew's previous objections to ArthroCare's discovery requests. We reserve the right to revise these responses as discovery proceeds. In particular, we reserve the right to revise these responses after we have received meaningful discovery on ArthroCare's claim construction and infringement contentions, and after the Court has construed the asserted claims.

Smith & Nephew objects to ArthroCare's improper attempts to informally amend its infringement allegations. Our responses concern (1) the Dyonics Control RF System which is the only product alleged in ArthroCare's Complaint to infringe and (2) the asserted claims originally identified in Jared Bobrow's November 2, 2001 letter. We are not providing responses at this time for the additional claims listed in your March 15 letter since that was the first notice we received, just two weeks ago, that those claims were being asserted. We are in the process of preparing responses to those additional claims, however, and expect to have them to you within the next two weeks.

In addition, and in response to your letter of March 27, 2002, we are also not providing responses at this time for the Dyonics Electroblade Resector ("Electroblade") since it is not in the case. As you know, Electroblade was not accused in ArthroCare's Complaint. The only product ArthroCare accused in its Complaint was the Dyonics Control RF System. Further, ArthroCare failed to move to amend its Complaint as it is required to do under the Rules, and the deadline for amending pleadings in this case expired on March 8, 2002. Instead, ArthroCare merely stated in a letter a week later that "Electroblade is now among the accused products."

As you know, the accusation of infringement in a patent lawsuit is a formal step in the case that carries with it certain burdens to investigate under Rule 11. *Judin v. United*

States, 110 F.3d 780 (Fed. Cir. 1997); *Antonious v. Spalding & Evenflo Companies, Inc.*, 275 F.3d 1066 (Fed. Cir. 2002). Indeed, in light of ArthroCare's argument during the discovery conference on March 5 that it needed discovery to determine whether Electroblade infringes, we were quite surprised that Electroblade was included in ArthroCare's infringement chart. Accordingly, we question whether ArthroCare can meet its burden under Rule 11 with respect to Electroblade.

Please let me know if you are in disagreement with any of the foregoing.

Very truly yours,

Keith Walter

Keith Walter

REDACTED

2. **U.S. Patent No. 5,697,882 ("the '882 patent")**

REDACTED

REDACTED

Smith & Nephew's Supplemental Response Re Invalidity

In addition to its previous objections, and without waiving any of those objections, Smith & Nephew also objects to providing its invalidity contentions at this time, since ArthroCare has refused to provide any of its contentions with respect to construction of the claims of its patents. Accordingly, Smith & Nephew reserves the right to supplement, amend, or otherwise modify its invalidity contentions as the case proceeds, and particularly after ArthroCare provides its proposed claim construction and/or after the Court construes the claims of ArthroCare's patents.

Nevertheless, as of the present time, Smith & Nephew incorporates its previous responses by reference, and further responds as follows:

Certain of Smith & Nephew's invalidity contentions are based on invalidity under 35 U.S.C. § 102 and/or § 103 in view of certain prior art references. In the interest of brevity and convenience, rather than repeat the full names of those references in connection with each such contention, Smith & Nephew will instead refer to those references by number, in accordance with the following table:

#	Issue/ Pub'n Date	Patent Number/ Publication	Inventor/Author	Title
1	08/16/33	US 2,056,377	F.C. Wappler	Electronic Instrument
2	05/00/69	Bio-Medical Engineering 206-216	A.K. Dobbie	The Electrical Aspects of Surgical Diathermy
3	06/11/74	US 3,815,604	Conor C. O'Malley, Ralph M. Heintz, Sr.	Apparatus For Intraocular Surgery
4	08/13/74	US 3,828,780	Charles F. Morrison, Jr.	Combined Electrocoagulator-Suction Instrument
5	01/00/75	IEEE Transactions On Biomedical Engineering	William M. Honig	The Mechanism of Cutting in Electrosurgery

#	Issue/ Pub'n Date	Patent Number/ Publication	Inventor/Author	Title
6	08/26/75	US 3,901,242	Karl Storz	Electric Surgical Instrument
7	11/18/75	US 3,920,021	Siegfried Hiltebrandt	Coagulating Devices
8	00/00/76	Acta Medicotechnica (Medizinal-Markt), Vol. 24, No. 4, 1976 129 – 134	E. Elsasser and E. Roos	Uber ein Instrument zur leckstromfreien transurethralen Resection (Concerning An Instrument for Transurethral resection without leakage of current)
9	02/24/76	US 3,939,839	Lawrence E. Curtiss	Resectoscope and Electrode Therefor
10	07/20/76	US 3,970,088	Charles F. Morrison	Electrosurgical Devices Having Sesquipolar Electrode Structures Incorporated Therein
11	01/07/77	2 313 949/ N 76 17587	Siegfried Hiltebrandt et Ludwig Bonnet	Boucle de sectionnement a une ou deux branches pour resertoscope
12	00/00/78	Gastroenterology, Vol. 74, No. 3, 527-534, 1978	J.R.A. Piercey, M.D., D.C. Auth, Ph.D, P.E., F.E. Silverstein, M.D., H.R. Willard, Ph.D, M.B. Dennis, D.V.M., D.M. Ellefson, B.S., D.M. Davis, M.S.E.E., R.L. Protell, M.D. and C.E. Rubin, M.D.	Electrosurgical Treatment of Experimental Bleeding Canine Gastric Ulcers: Development and testing of a computer control and a better electrode
13	02/21/78	US 4,074,718	Charles F. Morrison, Jr.	Electrosurgical Instrument
14	06/06/78	US 4,092,986	Max Schneiderman	Constant Output Electrosurgical Unit
15	09/26/78	US 4,116,198 and its file history	Eberhard Roos	Electro-Surgical Device
16	11/00/79	Digestive Diseases and Sciences, Vol. 24, No. 11, 845-848	M.B. Dennis, J. Peoples, R. Hulett, D.C. Auth, R.L. Protell, C.E. Rubin, and F.E. Silverstein	Evolution of Electrofulguration in Control of Bleeding of Experimental Gastric Ulcers

#	Issue/ Pub'n Date--	Patent Number/ Publication	Inventor/Author	Title
17	01/01/80	US 4,181,131	Hisao Ogiu	High Frequency Electrosurgical Instrument for Cutting Human Body Cavity Structures
18	01/22/80	US 4,184,492	Hans H. Meinke, Gerhard Flachenecker, Karl Fastenmeier, Friedrich Landstorfer, Heinz Lidenmeier	Safety Circuitry for High Frequency Cutting and Coagulating Devices
19	11/11/80	US 4,232,676	Andrew Herczog	Surgical Cutting Instrument
20	02/03/81	US 4,248,231	Andrew Herczog and James A. Murphy	Surgical Cutting Instrument
21	02/00/82	CRC Press, American Heart Journal, Vol. 117, 332-341	Kevin J. Barry, MS, Jonathan Kaplan, MD, Raymond J. Connolly, Ph.D, Paul Nardella, BS, Benjamin I. Lee, MD, Gary J. Becker, MD, Bruce F. Waller, MD, and Allan D. Callow, MD, Ph.D	The effect of radiofrequency-generated thermal energy on the mechanical and histologic characteristics of the arterial wall in vivo: Implications for radiofrequency angioplasty
22	04/27/82	US 4,326,529	James D. Doss and Richard L. Hutson	Corneal-Shaping Electrode
23	04/26/83	US 4,381,007	James D. Doss	Multipolar Corneal-Shaping Electrode with Flexible Removable Skirt
24	00/00/84	Gut, 25, 1424-1431	C.P. Swain, TN Mills, E. Shemesh, Julia M. Dark, M.R. Lewin, J.S. Clifton, T.C. Northfield, P.B. Cotton, and P.R. Salmon	Which Electrode? A comparison of four endoscopic methods of electrocoagulation in experimental bleeding ulcers

#	Issue/ Pub'n Date	Patent Number/ Publication	Inventor/Author	Title
25	00/00/85	Urological Research 13:99-102	J.W.A. Ramsay, N.A. Shepherd, M. Butler, P.T. Gosling, R.A. Miller, D.M.A. Wallace, H.N. Whitfield	A Comparison of Bipolar and Monopolar Diathermy Probes in Experimental Animals
26	06/00/85	JACC Vol. 5, No. 6, 1382-6	Cornelis J. Slager, MSc, Catharina E. Essed, MD, Johan C.H. Schuurbiers, BSc, Nicolaas Bom, Ph.D, Patrick W. Serruys, MD, Geert T. Meester, MD, FACC	Vaporization of Atherosclerotic Plaques by Spark Erosion
27	10/22/85	US 4,548,207	Harry G. Reimels	Disposable Coagulator
28	05/27/86	US 4,590,934	Jerry L. Malis, Leonard I. Malis, Robert R. Acorcey, David Solt	Bipolar Cutter/Coagulator
29	00/00/87	Kardiologie, Kardiol.76: Supp. 6, 67-71 (1987)	C.J. Slager, A.C. Phaff, C.E. Essed, J.C.H. Schuurbiers, N. Bom, V.A. Vandenbroucke, and P.W. Serruys	Spark Erosion of Arteriosclerotic Plaques
30	04/28/87	US 4,660,571	Stanley R. Hess, Terri Kovacs	Percutaneous Lead Having Radially Adjustable Electrode
31	06/23/87	US 4,674,499	David S.C. Pao	Coaxial Bipolar Probe
32	07/00/88	Valleylab Part Number 945 100 102 A	Valleylab, Inc.	Surgistat Service Manual
33	11/22/88	US 4,785,823	Philip E. Eggers, Robert F. Shaw	Methods And Apparatus For Performing In Vivo Blood Thermodilution Procedures
34	00/00/89	SPIE Vol. 1068 Catheter-based Sensing and Imaging Technology	Paul C. Nardella	Radio Frequency Energy and Impedance Feedback

#	Issue/ Pub'n Date	Patent Number/ Publication	Inventor/Author	Title
35	00/00/89	The Organizing Committee of the 7th World Congress on Endourology and ESWL Foundation for Advancement of International Science	Robert Tucker and Stefan Loening	A Bipolar Electrosurgical Turp Loop
36	02/21/89	US 4,805,616	David S.C. Pao	Bipolar Probes for Ophthalmic Surgery and Methods of Performing Anterior Capsulotomy
37	03/00/89	Journal of Urology Vol. 141, 662-665	Robert D. Tucker, Eugene V. Kramolowsky, Eric Bedell and Charles E. Platz	A Comparison of Urologic Application of Bipolar Versus Monopolar Five French Electrosurgical Probes
38	04/00/89	JACC Vol. 13 No. 5, 1167-75	Benjamin I. Lee, MD, FACC, Gary J. Becker, MD, Bruce F. Waller, MD, FACC, Kevin J. Barry, MS, Raymond J. Connolly, Ph.D, Jonathan Kaplan, MD, Alan R. Shapiro, MS, Paul C. Nardella, BS	Thermal Compression and Molding of Atherosclerotic Vascular Tissue With Use of Radiofrequency Energy: Implications for Radiofrequency Balloon Angioplasty
39	04/25/89	US 4,823,791	Frank D. D'Amelio, Dawn M. DeLemos, Dominick G. Esposito, Michelle D. Maxfield, Claude E. Petruzzi, Robert H. Quint	Electrosurgical Probe Apparatus
40	05/23/89	US 4,832,048	Donald Cohen	Suction Ablation Catheter
41	00/00/90	Urological Research 18:291-294	R.D. Tucker, E.V. Kramolowsky, and C.E. Platz	In vivo effect of 5 French bipolar and monopolar electrosurgical probes on the porcine bladder

#	Issue/ Pub'n Date	Patent Number/ Publication	Inventor/Author	Title
42	02/00/90	Journal of Urology Vol. 143, 275-277	Eugene V. Kramolowsky and Robert D. Tucker	Use of 5F Bipolar Electrosurgical Probe in Endoscopic Urologiical Procedures
43	04/05/90	WO 90/03152	John Considine, John Colin	Electro-surgical Apparatus for Removing Tumours from Hollow Organs of the Body
44	05/01/90	US 4,920,978	David P. Colvin	Method and Apparatus for the Endoscopic Treatment of Deep Tumors Using RF Hyperthermia
45	06/05/90	US 4,931,047	Alan Broadwin, Charles Vassallo, Joseph N. Logan, Robert W. Hornlein	Method and Apparatus For Providing Enhanced Tissue Fragmentation And/Or Hemostasis
46	06/26/90	US 4,936,281	Peter Stasz	Ultrasonically Enhanced RF Ablation Catheter
47	10/30/90	US 4,966,597	Eric R. Cosman	Thermometric Cardiac Tissue Ablation Electrode with Ultra-Sensitive Temperature Detection
48	12/11/90	US 4,976,711	David J. Parins, Mark A. Rydell, Peter Stasz	Ablation Catheter With Selectively Deployable Electrodes
49	12/25/90	US 4,979,948	Lesslie A. Geddes, Marvin H. Hinds, Joe D. Bourland, William D. Voorhees	Method and Apparatus for Thermally Destroying A Layer of An Organ
50	03/21/91	DE 3930451 A1	Ellen Hoffmann, Gerhard, Steinbeck, Rudi Mattmuller	Vorrichtung fur die Hochfrequenzkoagulation von biologischem Gewebe
51	04/16/91	US 5,007,908	Mark A. Rydell	Electrosurgical Instrument Having Needle Cutting Electrode And Spot-Coag Electrode
52	04/23/91	US 5,009,656	Harry G. Reimels	Bipolar Electrosurgical Instrument
53	07/30/91	US 5,035,696	Mark A. Rydell	Electrosurgical Instrument for Conducting Endoscopic Retrograde Sphincterotomy

#	Issue/ Pub'n Date	Patent Number/ Publication	Inventor/Author	Title
54	09/00/91	Journal of Urology Vol. 146, 669	Eugene V. Kramolowsky and Robert D. Tucker	The Urological Application of Electrosurgery
55	09/10/91	US 5,047,026	Mark A. Rydell	Electrosurgical Implement For Tunneling Through Tissue
56	09/10/91	US 5,047,027	Mark A. Rydell	Tumor Resector
57	10/07/91	Bipolar Laparoscopic Cholecystectomy Lecture	Dr. Olsen	Bipolar Laparoscopic Cholecystectomy
58	01/14/92	US 5,080,660	Terrence J. Buelna	Electrosurgical Electrode
59	01/28/92	US 5,084,044	Robert H. Quint	Apparatus for Endometrial Ablation and Method of Using Same
60	02/04/92	US 5,085,659	Mark A. Rydell	Biopsy Device With Bipolar Coagulation Capability
61	02/18/92	US 5,088,997	Louis Delahuerga, Robert B. Stoddard, Michael S. Klicek	Gas Coagulation Device
62	03/24/92	US 5,098,431	Mark A. Rydell	RF Ablation Catheter
63	04/28/92	US 5,108,391	Gerhard Flachenecker, Karl Fastenmeier, Heinz Lindenmeier	High-Frequency Generator For Tissue Cutting And For Coagulating In High-Frequency Surgery
64	05/12/92	US 5,112,330	Shinichi Nishigaki, Shiro Bito	Resectoscope Apparatus
65	06/16/92	US 5,122,138	Kim H. Manwaring	Tissue Vaporizing Accessory and Method for an Endoscope
66	12/01/92	US 5,167,659	Naoki Ohtomo; Shizuo Ninomiya	Blood Coagulating Apparatus
67	12/15/92	US 5,171,311	Mark A. Rydell, David J. Parins, Steven W. Berhow	Percutaneous Laparoscopic Cholectectomy Instrument
68	03/30/93	US 5,197,963	David J. Parins	Electrosurgical Instrument with Extendable Sheath for Irrigation and Aspiration
69	05/04/93	US 5,207,675	Jerome Canady	Surgical Coagulation Device

#	Issue/ Pub'n Date	Patent Number/ Publication	Inventor/Author	Title
70	06/08/93	US 5,217,459	William Kamerling	Method and Instrument for Performing Eye Surgery
71	04/26/94	US 5,306,238	Richard P. Fleenor	Laparoscopic Electrosurgical Pencil
72	06/13/95	US 5,423,882	Warren M. Jackman, Wilton W. Webster, Jr.	Catheter Having Electrode With Annular Recess and Method of Using Same
73	10/03/95	US 5,454,809	Michael Janssen	Electrosurgical Catheter And Method For Resolving Artherosclerotic Plaque By Radio Frequency Sparking

1. **U.S. Patent No. 5,697,536 ("the '536 patent")**

A. **Claim 45**

Smith & Nephew contends that claim 45 of the '536 patent is anticipated by at least each of the following references: 3, 8, 12, 15, 16, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 31, 33, 35, 36, 37, 38, 41, 42, 43, 45, 46, 48, 49, 51, 52, 53, 54, 57, 61, 63, 65, 66, 67, 69, 70, 71.

Smith & Nephew also contends that claim 45 of the '536 patent would have been obvious to one of ordinary skill in the art at the time of the invention in view of at least each of the following combinations of references, which Smith & Nephew contends would have been combined for at least the following reasons:

Combination	Motivation to Combine
Any one or more of 1, 4, 5, 6, 7, 9, 10, 11, 13, 16, 17, 20, 30, 33, 39, 40, 44, 50, 55, 56, 58, 60, 61, 62, 64, 68, 69, 71, 72, 73 with any one or more of 35, 54, 57.	Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure.
Any one or more of 1, 4, 5, 6, 7, 9, 10, 11, 13, 16, 17, 20, 30, 33, 39, 40, 44, 50, 55, 56, 58, 60, 61, 62, 64, 68, 69, 71, 72, 73 with any other one or more of the anticipating references listed above.	Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure.

Combination	Motivation to Combine
Any one or more of 35, 54, 57 with 59.	Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure.
Any one or more of 35, 54, 57 with any other one or more of the anticipating references listed above.	Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure.
Any one or more of 2, 34, 47 with any one or more of the anticipating references listed above.	Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure.
59 with any one or more of the anticipating references listed above.	Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure.

2. **U.S. Patent No. 5,697,882 ("the 882 patent")**

A. **Claim 1**

Smith & Nephew contends that claim 1 of the '882 patent is anticipated by at least each of the following references: 2, 3, 5, 8, 15, 16, 18, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 34, 35, 36, 37, 38, 42, 45, 46, 48, 49, 51, 52, 53, 54, 55, 57, 61, 62, 63, 65, 66, 67, 68, 71, 73.

Smith & Nephew also contends that claim 1 of the '882 patent would have been obvious to one of ordinary skill in the art at the time of the invention in view of at least each of the following combinations of references, which Smith & Nephew contends would have been combined for at least the following reasons:

Combination	Motivation to Combine
Any one or more of 1, 6, 7, 9, 11, 17, 30, 39, 40, 44, 47, 50, 55, 56, 58, 61, 62, 64, 68, 69, 71, 73 with any other one or more of the anticipating references listed above.	Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure.

Combination	Motivation to Combine
Any one or more of 1, 6, 7, 9, 11, 17, 30, 39, 40, 44, 47, 50, 55, 56, 58, 61, 62, 64, 68, 69, 71, 73 with any one or more of 2, 3, 4, 12, 16, 18, 21, 22, 23, 24, 25, 27, 28, 31, 33, 34, 35, 36, 37, 41, 42, 43, 45, 46, 48, 49, 51, 53, 54, 57, 60, 63, 66, 67, 70, 72 and with any one or more of 10, 13.	Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure.
Any one or more of 2, 3, 4, 12, 16, 18, 21, 22, 23, 24, 25, 27, 28, 31, 33, 34, 35, 36, 37, 41, 42, 43, 45, 46, 48, 49, 51, 53, 54, 57, 60, 63, 66, 67, 70, 72 with any other one or more of the anticipating references listed above.	Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure.
Any one or more of 2, 3, 4, 12, 16, 18, 21, 22, 23, 24, 25, 27, 28, 31, 33, 34, 35, 36, 37, 41, 42, 43, 45, 46, 48, 49, 51, 53, 54, 57, 60, 63, 66, 67, 70, 72 with any one or more of 10, 13.	Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure.
Any one or more of 10, 13 with any other one or more of the anticipating references listed above.	Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure.

Smith & Nephew further contends that claim 1 of the '882 patent is also invalid as indefinite under 35 U.S.C. § 112 ¶ 2.

B. Claim 26

Smith & Nephew contends that claim 26 of the '882 patent is anticipated by at least each of the following references: 2, 5, 23, 26, 29, 61, 63.

Smith & Nephew also contends that claim 26 of the '882 patent would have been obvious to one of ordinary skill in the art at the time of the invention in view of at least each of the following combinations of references, which Smith & Nephew contends would have been combined for at least the following reasons:

Combination	Motivation to Combine
Any one or more of 1, 6, 7, 10, 11, 13, 17, 30, 39, 40, 44, 47, 50, 55, 56, 58, 62, 64, 68, 69, 71, 73 with any one or more of 3, 4, 8, 12, 15, 16, 18, 21, 22, 23, 24, 25, 27, 28, 31, 33, 34, 35, 36, 37, 38, 41, 42, 43, 45, 46, 48, 49, 51, 52, 53, 54, 57, 60, 65, 66, 67, 70, 72 and with any one or more of 9, 14, 32, 61.	Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure.
Any one or more of 1, 6, 7, 10, 11, 13, 17, 30, 39, 40, 44, 47, 50, 55, 56, 58, 62, 64, 68, 69, 71, 73 with any one or more of the anticipating references listed above.	Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure.
Any one or more of 3, 4, 8, 12, 15, 16, 18, 21, 22, 24, 25, 27, 28, 31, 33, 34, 35, 36, 37, 38, 41, 42, 43, 45, 46, 48, 49, 51, 52, 53, 54, 57, 60, 65, 66, 67, 70, 72 with any one or more of 9, 14, 32, 61.	Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure.
Any one or more of 3, 4, 8, 12, 15, 16, 18, 21, 22, 24, 25, 27, 28, 31, 33, 34, 35, 36, 37, 38, 41, 42, 43, 45, 46, 48, 49, 51, 52, 53, 54, 57, 60, 65, 66, 67, 70, 72 with any one or more of the anticipating references listed above.	Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure.
Any one or more of 9, 14, 32, 61 with any one or more of the anticipating references listed above.	Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure.

Smith & Nephew further contends that claim 26 of the '882 patent is also invalid as indefinite under 35 U.S.C. § 112 ¶ 2.

C. **Claim 28**

Smith & Nephew contends that claim 28 of the '882 patent is anticipated by at least each of the following references: 8, 15, 21, 26, 29, 41, 42, 45, 57.

Smith & Nephew also contends that claim 28 of the '882 patent would have been obvious to one of ordinary skill in the art at the time of the invention in view of at least each of the following combinations of references, which Smith & Nephew contends would have been combined for at least the following reasons:

Combination	Motivation to Combine
Any one or more of 1, 6, 7, 9, 10, 11, 13, 17, 30, 39, 40, 47, 50, 55, 56, 58, 62, 64, 68, 69, 71, 73 with any one or more of 2, 3, 4, 5, 12, 16, 18, 19, 20, 22, 23, 24, 25, 27, 28, 31, 33, 34, 35, 36, 37, 38, 43, 46, 48, 49, 51, 52, 53, 54, 60, 63, 65, 66, 67, 70, 72 and with any one or more of 44, 61.	Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure.
Any one or more of 1, 6, 7, 9, 10, 11, 13, 17, 30, 39, 40, 47, 50, 55, 56, 58, 62, 64, 68, 69, 71, 73 with any one or more of the anticipating references listed above.	Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure.
Any one or more of 2, 3, 4, 5, 12, 16, 18, 19, 20, 22, 23, 24, 25, 27, 28, 31, 33, 34, 35, 36, 37, 38, 43, 46, 48, 49, 51, 52, 53, 54, 60, 63, 65, 66, 67, 70, 72 with any one or more of the anticipating references listed above.	Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure.
Any one or more of 2, 3, 4, 5, 12, 16, 18, 19, 20, 22, 23, 24, 25, 27, 28, 31, 33, 34, 35, 36, 37, 38, 43, 46, 48, 49, 51, 52, 53, 54, 60, 63, 65, 66, 67, 70, 72 with any one or more of 44, 61.	Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure.
Any one or more of 44, 61 with any one or more of the anticipating references listed above.	Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure.

Smith & Nephew further contends that claim 28 of the '882 patent is also invalid as indefinite under 35 U.S.C. § 112 ¶ 2.

3. **U.S. Patent No. 6,224,592 ("the '592 patent")**

A. **Claim 1**

Smith & Nephew contends that claim 1 of the '592 patent is anticipated by at least each of the following references: 8, 15, 23, 26, 30, 31, 33, 34, 46, 48, 51, 52, 62, 72.

Smith & Nephew also contends that claim 1 of the '592 patent would have been obvious to one of ordinary skill in the art at the time of the invention in view of at least

each of the following combinations of references, which Smith & Nephew contends would have been combined for at least the following reasons:

Combination	Motivation to Combine
Any one or more of 1, 6, 7, 9, 10, 11, 13, 17, 30, 39, 40, 44, 47, 50, 55, 56, 58, 62, 64, 68, 69, 71, 73 with any one or more of the other anticipating references listed above.	Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure.
Any one or more of 1, 6, 7, 9, 10, 11, 13, 17, 30, 39, 40, 44, 47, 50, 55, 56, 58, 62, 64, 68, 69, 71, 73 with any one or more of 2, 3, 4, 5, 12, 16, 18, 20, 21, 22, 24, 25, 27, 28, 29, 31, 33, 34, 35, 36, 37, 38, 41, 42, 43, 45, 49, 53, 54, 57, 60, 61, 63, 65, 66, 67, 70, 72 and with any one or more of the other anticipating references listed above.	Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure.
Any one or more of 2, 3, 4, 5, 12, 16, 18, 20, 21, 22, 24, 25, 27, 28, 29, 31, 33, 34, 35, 36, 37, 38, 41, 42, 43, 45, 49, 53, 54, 57, 60, 61, 63, 65, 66, 67, 70, 72 with any one ore more of the other anticipating references listed above.	Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure.

Smith & Nephew further contends that claim 1 of the '592 patent is also invalid as indefinite under 35 U.S.C. § 112 ¶ 2.

B. Claim 23

Smith & Nephew contends that claim 23 of the '592 patent is anticipated by at least each of the following references: 8, 15, 26, 30, 34, 46, 48, 51, 62, 72.

Smith & Nephew also contends that claim 23 of the '592 patent would have been obvious to one of ordinary skill in the art at the time of the invention in view of at least each of the following combinations of references, which Smith & Nephew contends would have been combined for at least the following reasons:

Combination	Motivation to Combine
Any one or more of 4, 5, 12, 16, 24, 25, 31, 36, 37, 38, 41, 42, 53, 61, 63, 65, 66, 67, 70, 72 with any one or more of the other anticipating references listed above.	Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure.
Any one or more of 2, 3, 18, 19, 20, 21, 22, 23, 27, 28, 29, 33, 34, 35, 43, 45, 49, 52, 54, 57, 60 with any one or more of the other anticipating references listed above.	Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure.
Any one or more of 2, 3, 18, 19, 20, 21, 22, 23, 27, 28, 29, 33, 34, 35, 43, 45, 49, 52, 54, 57, 60 with any one or more of 1, 7, 10, 17, 44, 55, 56 and any one or more of the other anticipating references listed above.	Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure.
Any one or more of 2, 3, 18, 19, 20, 21, 22, 23, 27, 28, 29, 33, 34, 35, 43, 45, 49, 52, 54, 57, 60 with 59 and any one or more of the other anticipating references listed above.	Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure.
Any one or more of 1, 7, 10, 17, 44, 55, 56 with any one or more of the other anticipating references listed above.	Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure.
Any one or more of 6, 9, 11, 13, 30, 39, 40, 47, 50, 58, 62, 64, 68, 69, 71, 73 with any one or more of the other anticipating references listed above.	Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure.
Any one or more of 6, 9, 11, 13, 30, 39, 40, 47, 50, 58, 62, 64, 68, 69, 71, 73 with 59 and any one or more of the other anticipating references listed above.	Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure.
59 with any one or more of the other anticipating references listed above.	Each reference is directed to the same problem – applying electrical energy to a target site on a patient's body structure.

4. **All Patents**

Smith & Nephew also contends that the asserted claims of the '536, '882 and '592 patents are also invalid under 35 U.S.C. § 102(f) and/or § 116 because of improper inventorship.

Smith & Nephew's investigation into its defenses is continuing, and it reserves the right to assert additional invalidity defenses as discovery progresses.